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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,775	11/27/2000	Joseph Sirgedas		4902

7590

10/24/2002

WOOD, PHILLIPS, VAN SANTEN, CLARK & MORTIMER  
500 WEST MADISON STREET, SUITE 3800  
CHICAGO, IL 60661

EXAMINER

EDMONDSON, LYNNE RENEE

ART UNIT	PAPER NUMBER
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1725

DATE MAILED: 10/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/722,775

Applicant(s)

SIRGEDAS, JOSEPH

Examiner

Lynne Edmondson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 8/8/02.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 contradicts the base claim. The base claim teaches that the ring of material is moved before melting leaving no material in the first location. However, claim 2 teaches that the material melts before moving. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4, 6, 8, 11, 13, 14, 16-18, 20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Sixsmith (USPN 4958857).

Sixsmith teaches a method of forming a meltable material at joint between telescopingly engaged male and female elements, said method comprising the steps of

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directing the male element (pipe 11) into the female element (pipe fitting 12), placing a ring of meltable material (thermoplastic sleeve 21) around the male element at a first location (figure 1 and col 2 lines 34-64 and col 3 lines 8-33) and sliding the material against the elements from a first location to a second location by a mounting collar (col 3 lines 50-68, col 5 lines 31-62 and figure 4). The material is melted and solidifies on cooling (col 4 lines 29-57). The sleeve surrounds the pipe forming a circle (360 degrees). The ring is not placed fully within the female element and abuts the free edge (46) of the female element (figure 1). See also Sixsmith claims 1, 8 and 15-20.

3. Claims 1, 4, 6, 8, 11, 13, 14, 16-18, 20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Carter et al. (USPN 3784239).

Carter teaches a method of forming a meltable material at joint between telescopingly engaged male and female elements, said method comprising the steps of directing the male element (pipe 14) into the female element (pipe fitting 24), placing a ring of meltable material (sleeve 16) around the male element at a first location and sliding the material against the elements from a first location to a second location by threads (col 3 lines 25-65 and col 6 lines 5-23). The collar material may be bent (wound) around the male element (col 4 lines 52-68) or placed as a preform (col 4 lines 12-32). The material is melted and solidifies on cooling (col 5 lines 21-56). The sleeve surrounds the pipe forming a circle (360 degrees). The ring is not placed fully within the female element and abuts the free edge (46) of the female element (figure 1). See also Sixsmith claims 1, 8 and 15-20.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lack et al. (USPN 6264062 B1).

Lack teaches a method of forming a meltable material at a joint between engaged male (128) and female (127) elements comprising the steps of placing a solder ring (103) around the male element such that the male member is directed through it (col 6 lines 56-68 and col 10 lines 8-33). The ring may also be placed in the female element with position changes performed by a dispenser (col 8 line 33-col 9 line 6). The elements are heated which melts the solder ring. The ring melts before moving (wicking) into the gap between the elements (col 2 lines 41-60, col 4 lines 20-37, col 7 lines 35-42 and figures 12-14). The joint is solidified on cooling (col 4 lines 30-35). The meltable material is bent around the male element (figure 10 and col 7 lines 3-12). The perform may take any form such as a wire (col 1 line 46), a split wire or ring (col 6 lines 36-55 and figure 8A-8B), a circular ring or a disk (col 2 lines 41-43 and figure 1). One form of the perform may have a protrusion (figure 6) which would not be fully within

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the female element (figures 14-18) when the elements are a pipe and a fitting (coupling) (col 4 line 60 – col 5 line 5). However, there is no disclosure of placing the ring with the male and female parts are engaged.

It would have been obvious to one of ordinary skill in the art at the time of the invention to place the ring via the dispenser while the parts are engaged as an obvious variation placement on the male or female parts prior to engagement (Lack, figures 23A-23E) to ensure proper location and sufficient amounts of solder for pipe fittings (Lack, col 2 lines 41-59) in a safe, simple and consistent manner (Lack, col 2 lines 1-27).

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kubota (JPN 10-238671 A), Hubbel (USPN 3639721, teaches conventional practice to push a solder ring from one location to another before melting), Dawson (USPN RE28457, threaded welding sleeve), Dolder et al. (EPN 0493316 A1), Zopfi (USPN 3998478, invention without melting), Lancien et al. (USPN 5796045),

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Chelette (USPN 4705307), Overy (GB 2092692 A), Conn et al. (USPN 5450666),  
Frederick (GB 2126298 A) and Belicic (USPN 3968982).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynne Edmondson whose telephone number is (703) 306-5699. The examiner can normally be reached on M-F from 7-4 with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (703) 308-3318. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7118 for regular communications and (703) 305-7115 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

Lynne Edmondson  
Examiner  
Art Unit 1725

10/21/02

LRE  
October 21, 2002